

REMARKS

The Official Action mailed March 5, 2008, has been received and its contents carefully noted. Filed concurrently herewith is a *Request for One Month Extension of Time*, which extends the shortened statutory period for response to July 5, 2005. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on June 5, 2006; and June 21, 2006.

A further Information Disclosure Statement is submitted herewith and consideration of this Information Disclosure Statement is respectfully requested.

Claims 1-30 were pending in the present application prior to the above amendment. The Applicant notes with appreciation the indication of the allowability of claims 10, 18, 21 and 27 (Box 7, Office Action Summary; page 6, Paper No. 20080223). The features of claims 10 and 21 have been incorporated into independent claims 1-4 and 12-15. Also, claims 1, 3, 4, 6, 12-17, 23, 24, 27 and 29 have been amended to better recite the features of the present invention. Accordingly, claims 1-9, 11-20 and 22-30 are now pending in the present application, of which claims 1-4, 12-15, 23, 24 and 29 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 1 of the Official Action asserts that "[c]laims 1-9, 11-17 and 19-20 of this application conflict with claims 1-19 of Application No. 11/007,645" (page 2, *Id.*). The Official Action has not provided any specific arguments to support the rejection. However, the Official Action relies on MPEP § 822 and 37 CFR 1.78(b) in making the rejection.

MPEP § 822 sets forth the following (emphasis added): "The treatment of plural applications of the same inventive entity, none of which has become a patent, is treated in 37 CFR 1.78(b)" The Applicant notes that the '645 application issued as U.S. Patent No. 7,271,076 to Yamazaki on September 18, 2007; therefore, the above-referenced rejections are not proper. In any event, the Applicant has amended

independent claims 1-4 and 12-15 of the present application to recite the allowable features of dependent claims 10 and 21, i.e. that the substrate is a glass substrate or a quartz substrate. Reconsideration and withdrawal of the double patenting rejections are requested.

Paragraph 3 of the Official Action rejects claims 23, 24, 27 and 29 under 35 U.S.C. § 112, second paragraph, asserting that the term "heat-resistant" is indefinite. In response, the Applicant has amended claims 3, 4, 6, 12, 13, 17, 23, 24, 27 and 29 to delete the term "heat-resistant."

Also, at this opportunity, in connection with the "heat-resistant" feature, the Applicant has amended minor informalities in the specification at page 13, lines 7-10. Specifically, the Applicant has amended this portion of the specification as follows: "A heat-resistant organic resin such as siloxane, or an organic resin such as polyimide, acrylic, and polyamide, ~~or siloxane~~ can be used to form the second interlayer insulating film 46"

The Applicant respectfully submits that the amended claims, when read in light of the specification, are definite. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 112 are in order and respectfully requested.

Paragraph 5 of the Official Action rejects claims 23-30 as anticipated by U.S. Publication No. 2004/0016115 to Hashimoto. Although the Examiner includes claims 29 and 30 in the list of rejected claims at page 3 of the Official Action, it does not appear that the Examiner has included specific arguments to address the features recited in claims 29 and 30. That is, the Official Action appears to only address claims 23-28 at pages 3-5 of the Official Action. Therefore, the Applicant believes that the Examiner only intended to reject claims 23-28 as allegedly anticipated by Hashimoto. If necessary, the Applicant respectfully requests clarification of this matter in a future communication. In any event, the Applicant respectfully traverses the rejection because the Official Action has not established an anticipation rejection.

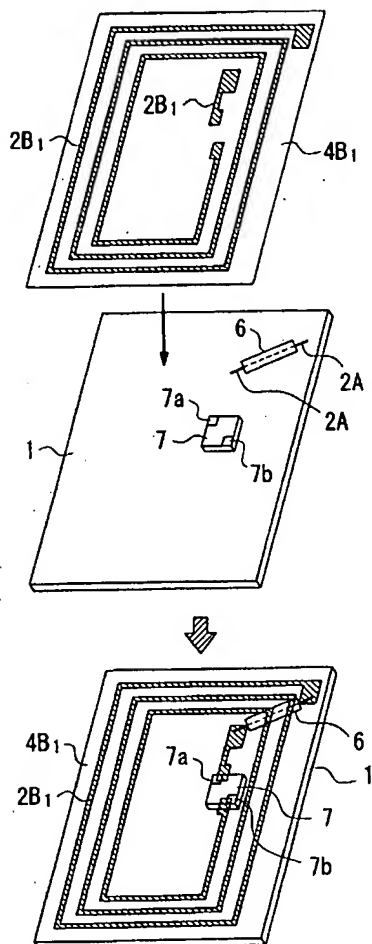
As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Applicant respectfully submits that an anticipation rejection cannot be maintained against the independent claims of the present application. Specifically, independent claims 23, 24 and 29 recite a thin film integrated circuit formed over a substrate with a base film interposed therebetween. For the reasons provided below, the Applicant respectfully submits that Hashimoto does not teach the above-referenced features of the present invention, either explicitly or inherently.

The Official Action asserts that "Hashimoto teaches ... a thin film integrated circuit 7 formed over a substrate 1 *with a base film 4B interposed therebetween*" (page 3, Paper No. 20080223; underlining in original, italics added for emphasis). The Applicant respectfully disagrees and traverses the assertions in the Official Action.

The Applicant respectfully submits that Hashimoto appears to disclose an IC chip 7 that is interposed between a substrate 1 and an insulating layer 4B₁ (see Hashimoto, Figure 13, reproduced below, and ¶ 0064).

FIG. 13



The reproduction of Figure 13 at page 3 in the Official Action renders the drawing in a manner that makes the configuration of the thin IC chip 7, the substrate 1 and the insulating layer 4B₁ unclear. However, as shown above, Figure 13 clearly shows and Hashimoto clearly discloses that the IC chip 7 is interposed between the substrate 1 and the layer 4B₁ (see ¶ 0064).

Therefore, the Applicant respectfully submits that Hashimoto does not teach a thin film integrated circuit formed over a substrate with a base film interposed therebetween, either explicitly or inherently.

Since Hashimoto does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained.

Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

Paragraph 13 of the Official Action rejects claims 29 and 30 as obvious based on the combination of Hashimoto and U.S. Patent No. 6,621,153 to Kawai. The Applicant respectfully traverses the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Please incorporate the arguments above with respect to the deficiencies in Hashimoto. Kawai does not cure the deficiencies in Hashimoto. Specifically, the Official Action relies on Kawai to allegedly teach "that an IC tag can function in a coin" (Paper No. 20080223, ¶ 13). However, Hashimoto and Kawai, either alone or in combination, do not teach or suggest the following features or that Hashimoto should be modified to include any of the following features: a thin film integrated circuit formed over a substrate with a base film interposed therebetween. Since Hashimoto and Kawai

do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Eric J. Robinson
Reg. No. 38,285

Robinson Intellectual Property Law Office, P.C.
PMB 955
21010 Southbank Street
Potomac Falls, Virginia 20165
(571) 434-6789